



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,795	04/24/2001	Jonathon J. Lipman	70788	6804

22242 7590 04/15/2003

FITCH EVEN TABIN AND FLANNERY
120 SOUTH LA SALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

EXAMINER

MCCROSKY, DAVID J

ART UNIT	PAPER NUMBER
----------	--------------

3736

DATE MAILED: 04/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/841,795

Applicant(s)

LIPMAN, JONATHON J.

Examiner

David J. McCrosky

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 9 is/are allowed.
- 6) ☒ Claim(s) 1-8, 10, 12-17 and 20 is/are rejected.
- 7) ☒ Claim(s) 11, 18 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3736

DETAILED ACTION***Specification***

The disclosure is objected to because of the following informalities: Applicant improperly states in the first paragraph of the specification that the present application is a continuation-in-part of a provisional application. Applicant is essentially claiming priority to a provisional application under 35 U.S.C. 120, which is not possible; if Applicant wishes to claim priority to a PCT, "published in English under PCT Article 21(2) and now abandoned" should be added. See MPEP § 1895.01. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-8, 12-14 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Iliff. The reference discloses a system and method that uses a computer or telephone network to communicate with the patient. See col. 4. Questions concerning pain, such as chest pain or head injuries, are asked. See cols. 38 and 39. The answers are processed and results are generated. See col. 35, ll. 53-67.

Art Unit: 3736

Consultations are repeated at different times. See col. 38, ll. 1-7. A pain scale is implemented. See col. 54, ll. 13-20.

Claims 1-4, 6, 7, 10, 12-17 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Eberlein. The reference discloses a patient communication device (102) that is in communication with a data processor (106). See col. 2, ll. 54-65. The patient communication device can be installed on a PDA. See col. 3, ll. 3-7. The patient answers a series of questions over time. The answers are then communicated to a database and are processed for graphical display. See col. 3, ll. 31-44.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 3-7 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al in view of Levitas et al. Wilson et al teach a patient communication device that is integral with an infusion apparatus. The infusion apparatus has a display which delivers questions to the patient. The recorded answers are stored in a non-volatile memory and analyzed by a physician to determine effectiveness of a particular infusion therapy. See col. 15, ll. 29-36. The questions are asked before and after the infusion. See col. 16. While disclosing the step of processing the recorded answers by health care personnel, Wilson et al do not teach processing the recorded answers using a data processor. However, Levitas et al teach

Art Unit: 3736

obtaining data from a patient and processing the data by a manual or automatic means and altering the infusion therapy accordingly. See col. 13, ll. 25-34. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the manual process of processing data, performed by the health care provider in Wilson et al, with the automatic means taught by Levitas et al to quickly analyze data.

Furthermore, it was known at the time of the invention that merely providing an automatic means to replace a manual activity, which accomplishes the same result is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of processing the pain questionnaire renders the same result as that of the manual step shown in Wilson et al. In other words there is no enhancement found in the claimed step. The claimed modification step only provides automating the manual activity. The end result is the same as compared to the manual method. A computer can simply iterate the steps faster.

Response to Arguments

Applicant's arguments filed February 19, 2003 have been fully considered but they are not persuasive. Iliff discloses a system and method, which monitors a patient in order to generate a diagnosis. The monitoring feature allows the patient to re-enter the system from an earlier consultation in order to monitor the patient over time. See col. 38, ll. 1-4.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

Art Unit: 3736

(i.e., monitoring pain) are not recited in claim 12. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's arguments, the recitation "patient pain management" in claim 12 has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Allowable Subject Matter

Claim 9 is allowed.

The following is an examiner's statement of reasons for allowance: the prior art does not teach the use of a pain questionnaire, which implements all of the claimed scales.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Art Unit: 3736

Claims 11, 18 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: while prior art such as Tuckett et al teach recording voluntary patient responses to thermal stimuli, a pain questionnaire to record and process responses to thermal stimuli on a data processor is not taught or suggested.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. McCrosky whose telephone number is 703-305-1331. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on 703-308-3130. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

DJM
April 9, 2003


ERIC F. WINAKUR
PRIMARY EXAMINER